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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,942	11/06/2001	Hartmus Ahrens	ACR2691P1US	6527

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EXAMINER	
HARDEE, JOHN R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,942	AHRENS ET AL.	
	Examiner	Art Unit	
	John R Hardee	1751	

-- The MAILING DATE of this communication appears n the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *2,3,7,12 and 13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6,8 and 14* is/are rejected.

7)☒ Claim(s) *9 and 10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group IA in Paper No. 9 is acknowledged. The traversal is on the ground(s) that a process for the derivatization of monoamines will be useful for the derivatization of diamines; because no restriction was required in the parent PCT; and because the claimed reaction sequence affords mixtures of products. This is not found persuasive because the examiner has followed the procedure for a restriction under lack of unity rules and is satisfied, upon reconsideration, that the restriction is warranted: Where portions of a claimed structure are variable, the portion which is not variable must make a contribution over the prior art. If it does not, lack of unity exists. See PCT Rule 13.2. In response to applicant's arguments however, applicant's claims are drawn primarily to a family of compounds, not to a process. Restriction among the compounds does not appear to have been traversed, but if applicant wishes to state on the record that any of the claimed compounds would be obvious over a disclosure of one of the others, the examiner will reconsider the restriction requirement. Whether or not the International Searching Authority chose to restrict has no bearing on the US case. Grounds for doing so clearly exist, regardless of whether or not this was done.

The requirement is still deemed proper and is therefore made FINAL. Claims 2, 3, 12 and 13 are withdrawn from consideration by the examiner as being drawn to inventions non-elected with traverse.

2. Further restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 4-6, 8, 9 and 14, drawn to quaternary ammonium monoesters and methods for making same.

Group II, claim(s) 7, drawn to precursors for making quaternary ammonium monoesters.

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Reasons are of record in the previous office action.

4. During a telephone conversation with Mr. Ralph Mancini on August 26, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 4-6, 8, 9 and 14. Affirmation of this election must be made by applicant in replying to this Office action. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The remaining claims have been searched and examined only to the extent that they read on the elected subject matter. No claims can pass to issue until all non-elected subject matter has been deleted from the claims.

Information Disclosure Statement

7. The cited journal articles appear to have been lost by the Office. The examiner apologizes for the inconvenience. If applicant wishes to have them considered, copies must be provided.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1, 4-6, 8-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 330,261 A1. The reference discloses fabric softening compositions comprising 2-hydroxypropyl monoesters of the form shown in the figure at p. 4, line 55. R1 is a hydrocarbyl group of 14-22 carbons; R2 is a hydrocarbyl group of 13-21 carbons, and R is alkyl or hydroxyalkyl of 1-6 carbons (p. 5, top). All of the R groups may be unsaturated. Fabric softening compositions according to the invention comprise about 1-20% of this monoester and a carrier solvent (p. 3, lines 49+). These compositions may further comprise cationic and nonionic surfactants (examples, p. 6, lines 55+). These compositions do not comprise a quat exactly as portrayed in claim 1. However, it would have been obvious at the time the invention was made to incorporate such a quat, because the prior art quats are one-carbon homologs of quat II of claim 1. Accordingly, the person of ordinary skill in the surfactant art would expect the claimed quat to have the same properties as those of the prior art.

Allowable Subject Matter

12. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record is the reference relied upon above. In the reference, a composition comprising a fatty acid and a tertiary amine, which would result in a protonated tertiary amine, is treated with epichlorohydrin. Applicant treats the amine-fatty acid composition with an unsaturated epoxide. Such an epoxide is not an art-accepted equivalent of the epichlorohydrin disclosed in the prior art.

14. Any prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

John R. Hardee
Primary Examiner
August 26, 2003